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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,054	12/11/2001	Moon-Young Kim	12777.13US01	7031
23552	7590	05/04/2005	EXAMINER	
MERCHANT & GOULD PC			FOSTER, ROLAND G	
P.O. BOX 2903			ART UNIT	PAPER NUMBER
MINNEAPOLIS, MN 55402-0903			2645	

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,054

Applicant(s)

KIM, MOON-YOUNG

Examiner

Roland G. Foster

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

In the amendment, filed on November 22, 2004, the applicant argued that U.S. Patent Publication No. 2003/01812021 A1 ("Bomze") was unavailable as prior art because Bomze was abandoned, hence the prior art date of Bomze is the publication date.

Applicant's arguments were duly considered but not deemed persuasive. Bomze was rejected under 35 USC § 102(e) in the last Office action. The following is a quotation from the last Office action of the appropriate paragraph of §35 U.S.C. that formed the basis for the rejection.

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

35 USC § 102(e) (emphasis added).

Thus, the applicant was provided notice that Bomze was prior art under 35 USC § 102(e) as a published patent application filed before the applicant's invention.

Applicant's amendment of claim 3 was sufficient to correct the antecedent basis problem described in the last Office action. Thus, the prior 35 USC § 112 rejection is withdrawn.

For the above reasons, the following rejections are repeated.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent

Application Publication No. US 2003/0181201 A1 ("Bomze"), as used in the last Office action.

See the following paragraphs for details on how Bomze anticipates particular limitations within the claim.

The limitation "(a) receiving advertisement data through a wireless Internet network" reads on the abstract where a mobile computing device 10 receives advertisement data through a wireless network. The advertisement data is sent by web server 12 through the wireless network to the browser enabled device 10 (paragraphs 0026 and 0027). Therefore, Bomze discloses that the advertisement data is transferred through a wireless Internet network.

The limitation "(b) comparing the received advertisement data with advertisement data stored in a storage device of a mobile communication terminal, to thus update the received advertisement data" reads on Bomze as follows. The received advertisement data includes a removal message (paragraph 0057), which is compared to with related advertisement data previously received and stored in the storage device of the device 10 (mobile terminal) in order to be removed (the previously received advertisement message and related data) (paragraphs 0058 and 0059).

The limitation "(c) determining whether the mobile communication terminal is activated and selecting advertisement data to be displayed on a display of the mobile communication terminal from the storage device according to the determination result" reads on Bomze as follows. Determining whether the mobile terminal is activated and selecting advertisement data accordingly can be interpreted as determining whether a the terminal is used to make a telephone call, or whether information is transmitted and received at the mobile terminal consistent with applicant's specification (e.g., see page 7, second paragraph). Similarly, the advertising system of Bomze determines whether the mobile terminal (mobile device 10) is activated when the user utilizes the mobile terminal to contact (call) an electronic commerce company, and when information can transmitted and received at the mobile terminal while carrying out this electronic commerce. Note also that the user can directly select (activate) the advertisement function at the mobile terminal (paragraph 0046). The displayed advertisements were previously stored and correlated with user data and are thus retrieved from a memory (storage) device in the mobile terminal when displayed (Fig. 1B and paragraph 0045).

The limitation "(d) displaying the selected advertisement data on the display of the mobile communication terminal" reads on paragraph 0054.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bomze as applied to claim 1 above, and further in view of U.S. Patent No. 6,084,583 ("Gerszberg"), as used in the last Office action.

Bomze discloses most limitations within this claim. Specifically, Bomze discloses determining whether the advertising function in the mobile terminal is activated by determining whether the user placed a call, transmitted and received information, or directly activated the function as discussed above. Bomze also discloses that the activated advertisement data stored in the storage device of the mobile terminal is then selected. See the claim 1 rejection for further details.

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However, Bomze fails to disclose "selecting the deactivated advertisement data stored in the storage device when the mobile communication terminal is deactivated."

However, Gerszberg teaches of a wireless, Internet network based, "active" advertising system using a screen based telephone (abstract, col. 2, lines 1-16, and col. 5, lines 1-27) that also supports the selection of deactivated advertisement data stored in the storage device (screen saver memory) when the terminal is inactive (deactivated) (abstract).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the selection of deactivated advertisement data stored in the storage device of the terminal when the terminal is inactive as taught by the wireless, Internet network based, active advertising system using a screen based telephone of Gerszberg to the wireless, Internet network based, active advertising system of Bomze that also uses a screen based telephone.

The suggestion/motivation for doing so would have been to increase revenue and reduce cost by providing a 'cheap medium for advertising while protecting the touch screen displays of video telephones" (Gerszberg, col. 2, lines 29-36), which has applicability to the telephone display of Bomze.

Allowable Subject Matter

Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Examiner's Reasons for Indicating Allowable Subject Matter

See the examiner's last Office action, mailed on May 21, 2004, for further details regarding the examiner's indication of allowable subject matter.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland G. Foster whose telephone number is (571) 272-7538.

The examiner can normally be reached on Mon to Fri from 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Roland G. Foster
Primary Patent Examiner
May 1, 2005